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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/299,068 04/23/99 WILLIAMSON

W 25932-5

022504 IM52/0305
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EXAMINER

MEDLEY, M

ART UNIT

PAPER NUMBER

1714

DATE MAILED:

03/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/299068

Applicant(s)

WILLIAMSON et al

Examiner

MEDLEY

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 11/3/00 and 1/11/01 telephone interview.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-35 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-38 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

The 35 U.S.C. Section 101 double patent rejection of claims 1-35 is withdrawn in view of applicants filing of an express letter of abandonment on January 12, 2001 in the parent application 09/234,019.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-9 and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urushibata et al 5,304,316 in view of Funahaski et al 4,696,869 and Lindemann 3,322,703 for reasons made of record in Paper No. 5, dated April 28, 2000.

Claims 20-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urushibata et al 5,304,316 in view of Funabashi et al 4,696,869 and Lindemann as applied to claims 1-9 and

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11-19 above, and further in view of Zehler 4,601,840 for reasons made of record in Paper No. 5, dated April 28, 2000.

Claims 1-8 and 11-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi 4,489,194, 4,509,955 and 4,486,573 for reasons made of record in Paper No. 5, dated April 28, 2000.

Claims 1-6, 11-16 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le Suer Re 32,174 for reasons made of record in Paper No. 5, dated April 28, 2000.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 and 11-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Baillargen et al 5,284,496 for reasons made of record in Paper No. 5, dated April 28, 2000.

Claims 1-6 and 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by LeSuer Re 32,174 for reasons made of record in Paper No. 5, dated April 28, 2000.

Applicants amendment to claim 28 has overcome the objection to claim 28.

Applicants amendment to claim 10 has overcome the 35 U.S.C. 112 first paragraph and part of the 35 U.S.C. 112 second paragraph for the deletion of "ethylene diamine" and "lubricity additive".

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 is indefinite for “the first moiety, second moiety... consisting of in order” in that it is confusing as to what is intended. The rejection may be overcome with the insertion of --- respectively--- after “of in” and ---for each anti-wear compound--- after “order”. Claim 10 is further indefinite in that the compound of lines 3-4 duplicate the compound of line 4. The proposed amendment to claim 10 to change “sorbitol” to “sorbet” would render the claim indefinite in that “sorbet” does not appear to be a considered third moiety” when viewed in light of claim 5 Markush grouping for the third moiety.

Applicant's arguments filed November 3, 2000 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the first moiety, the second moiety and the third moiety, which are set forth only in claims 2, 3-4, and 5, 12, 13-14 and 15; 21, 22-23 and 24; and 29, 30-31 and 32, respectively) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the

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specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is noted that applicants claimed first reaction is just merely mixing the first moiety with a second moiety in a molar ratio of from about 1:2 to about 2:1 at a temperature of from about 220°C to about 320°C under an inert atmosphere. A review of the rejections made of record in Paper No. 5 dated April 28, 2000 and the columns and lines location of such teachings indicate that the prior art met the 102/103, 103 and 102 criteria which anticipates, or in the alternative render obvious the claimed rejections of record. Applicants claims are written so broadly that they are anticipated by or rendered obvious by the prior art because the independent claims do not have specific compound reactants. Also, with respect to claims 2, 3-4 and 5; 12, 13-14 and 15; 21, 22-2 and 24; and 29, 30-31 and 32, it was suggested that applicants should incorporate their limitations into their independent claims. Also it was suggested that applicants should also amend the said dependent claims to delete the Markush grouping compounds which are clearly taught by the prior art because the Markush grouping indicate that the grouping of compounds are functional equivalent for the same intended function. For example Hayashi teaches polyolefin reacted with maleic acid or maleic anhydride and further reacted with a polyhydroxy compound which render obvious the claimed invention, note claims 1 and 24.

Claim 10 contains allowable subject matter.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Margaret B. Medley at telephone number (703) 308-2518.

Mmedley:vh

02/28/01


MARGARET MEDLEY
PRIMARY EXAMINER